

REMARKS

This application has been carefully reviewed in light of the Office Action of May 20, 2005, wherein:

A. Claims 1, 17, and 20 were rejected under 35 U.S.C. 102(b), first paragraph.

Turning now to the Office Action, the Examiner rejected Claims 1, 17 and 20 under 35 U.S.C. 102(b) as being clearly anticipated by Meador et al. With respect to Claim 17, the Examiner stated that Meador et al. discloses a rod which is press fit with the proximal portion of the impact member.

Claims 1 and 20

Claims 1 and 20 have been cancelled. Thus, the Applicant respectfully requests that this rejection be withdrawn.

Claim 17

Regarding Claim 17, the Examiner misinterprets Meador et al. Meador et al. discloses “a cylindrically shaped nail driving portion 34, a rear end portion of which is press fitted and glued or welded into a cylindrically shaped shaft 35 concentrically drilled into a forward end of the end section 28 [of the rod].” See Meador et al., Column 2, lines 44-47. The rod the Examiner refers to is permanently affixed with the impact member (i.e., nail driving portion).

Meador et al. is to be contrasted with the present invention where the impact member includes an attachment portion that allows a user to “removably attach an extension with the attachment portion.” See the Present Application, Paragraph 41. The attachment portion of the present invention is entirely different than that of Meador et al. For further clarification, Claim 17 has been amended to include the following limitation, “wherein the attachment portion is formed such that a user may removably attach an extension with the attachment portion...”

Additionally, Claim 17 has been amended to include all of the limitations of the base claim from which it depends.

Because Meador et al. does not teach all of the claimed limitations of Claim 17, the Applicant respectfully requests that this rejection be withdrawn and provide for timely allowance of the claim.

B. Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond.

The Examiner stated that Meador et al. discloses all of the claimed subject matter except for having a beveled head portion. The Examiner further stated that Hallock discloses a beveled "19" head portion, and that Bond discloses a beveled "9" head portion. The Examiner concluded that it would have been obvious to one having ordinary skill in the art to form the head portion of Meador et al. as beveled to impact and countersink a work piece as taught by Hallock or Bond.

Claim 2 has been cancelled. Thus, the Applicant respectfully requests that this rejection be withdrawn.

C. Claims 3, 9 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, as applied above, in further view of Borkowski.

Claim 3

Regarding Claim 3, the Examiner stated that Borkowski discloses a distal rubber surface engager and that it would have been obvious to one having ordinary skill in the art to form the device of Meador et al with a rubber surface engager to prevent marring of the workpiece as taught by Borkowski.

Borkowski was filed on February 25, 2003. As sworn to in the attached declaration, the present invention was invented at least as early as February 10, 2003 and was diligently pursued with the purpose of its reduction to practice or until the priority filing date of February 10, 2004. The Declaration under 37 CFR 1.131, submitted herewith as Appendix A, is sufficient to "swear behind" the effective date of Borkowski.

Claim 3 has been amended to include all of the limitations of the base claim and the intervening claim from which it depends. Thus, the Applicant respectfully requests that the Examiner withdraw this rejection and provide for timely allowance of Claim 3.

Claim 9

Regarding Claim 9, the Examiner stated that Bond discloses a retractor "11." The Examiner concluded that it would have been obvious to one having ordinary skill in the art to provide the device of Meador et al with a retractor to permit adjustments to be made as taught by Bond.

The Applicant refers the Examiner to the comments above regarding Claim 3. As Borkowski does not teach all of the claimed limitations in Claim 3, the Applicant believes that this Claim, which depends therefrom, is also allowable for at least the same reasons. Thus, the Applicant respectfully requests that this rejection be withdrawn.

Claim 12

Regarding Claim 12, the Examiner stated that Meador et al. discloses a rod which is press fit with the proximal portion of the impact member. Claim 12 has been amended to include the limitations described above in reference to Claim 17.

The Applicant refers the Examiner to the comments above regarding Claims 3 and 17. Because neither Meador et al. nor Borkowski, either alone or combined, teach all of the limitations in Claims 3 and 17, the Applicant believes that this Claim, which depends partially therefrom, is also allowable. Thus, the Applicant respectfully requests that this rejection be withdrawn.

D. Claims 4, 5, and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al. in view of Hallock or Bond, and Borkowski, as applied above, in further view of Schutz.

Claims 4 and 5

Regarding Claims 4 and 5, the Examiner stated that Schutz discloses an extender "2" and a cock and release mechanism "8, 9." The Examiner further stated that it would have been obvious to one having ordinary skill in the art to form the device of Meador et al. with an extender to force the impact member from the retracted to the extended position to impact a work piece as taught by Schutz. The Examiner concluded that it would have been

obvious to one having ordinary skill in the art to form the device of Meador et al. with a cock and release mechanism to provide a faster insertion of the fastener as taught by Schutz.

The Applicant refers the Examiner to the comments above regarding Claim 3. As Borkowski does not teach all of the claimed limitations in Claim 3, the Applicant believes that this Claim, which depends therefrom, is also allowable for at least the same reasons. Thus, the Applicant respectfully requests that this rejection be withdrawn.

Claim 8

With respect to Claim 8, the Examiner stated that Meador et al. discloses a rod which is press fit with the proximal portion of the impact member. Claim 8 has been amended to include the limitations described above in reference to Claim 17.

The Applicant refers the Examiner to the comments above regarding Claims 3 and 17. Because neither Meador et al. nor Borkowski, either alone or combined, teach all of the limitations in Claims 3 and 17, the Applicant believes that this Claim, which depends partially therefrom, is also allowable. Thus, the Applicant respectfully requests that this rejection be withdrawn.

E. Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al. in view of Hallock or Bond, Borkowski, and Schutz as applied above, in further view of Eby.

The Examiner stated that Eby discloses a handle pole "116" attached to the proximal portion of an impact member and extends beyond a guide member, a sliding attachment portion (see tool "136" slidable on pole "116") whereby the device is usable to set a fastener or as a hammer. The Examiner concluded that it would have been obvious to one having ordinary skill in the art to provide the handle pole "30" of Meador et al. with a sliding attachment portion to allow for the impact member to be driven or for the attachment to a tool as taught by Eby.

The Applicant refers the Examiner to the comments above regarding Claim 3. As Borkowski does not teach all of the claimed limitations in Claim 3, the Applicant believes that this Claim, which depends therefrom, is also allowable for at least the same reasons. Thus, the Applicant respectfully requests that this rejection be withdrawn.

F. Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al. in view of Hallock or Bond, and Borkowski as applied above, in further view of Eby.

The Examiner stated that Eby discloses a handle pole "116" attached to the proximal portion of an impact member and extends beyond a guide member, a sliding attachment portion (see tool "136" slidable on pole "116") whereby the device is usable to set a fastener or as a hammer. The Examiner concluded that it would have been obvious to one having ordinary skill in the art to provide the handle pole "30" of Meador et al. with a sliding attachment portion to allow for the impact member to be driven or for the attachment to a tool as taught by Eby.

The Applicant refers the Examiner to the comments above regarding Claim 3. As Borkowski does not teach all of the claimed limitations in Claim 3, the Applicant believes that this Claim, which depends therefrom, is also allowable for at least the same reasons. Thus, the Applicant respectfully requests that this rejection be withdrawn.

G. Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al. in view of Borkowski.

The Examiner stated that Borkowski discloses a distal rubber surface engager. The Examiner concluded that it would have been obvious to one having ordinary skill in the art to form the device of Meador et al. with a rubber surface engager to prevent marring of the workpiece as taught by Borkowski.

Claim 13 has been amended to include all of the limitations of the base claim and any intervening claims from which it depends. Additionally, The Applicant refers the Examiner to the comments above regarding Claim 3. As Borkowski does not teach all of the claimed limitations in Claim 3, the Applicant believes that this Claim, which has the same limitation, is also allowable for at least the same reasons. Thus, the Applicant respectfully requests that this rejection be withdrawn.

H. Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Bond.

The Examiner stated that Meador et al. discloses all of the claimed subject matter except for having a retractor. Bond discloses a retractor "11". The Examiner concluded that

it would have been obvious to one having ordinary skill in the art to provide the device of Meador et al with a retractor to permit adjustments to be made as taught by Bond.

Claim 14 has been cancelled. Thus, the Applicant respectfully requests that this rejection be withdrawn.

I. Claims 15 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Schutz.

The Examiner stated that Schutz discloses an extender "2" and a cock and release mechanism "8, 9". The Examiner further stated that it would have been obvious to one having ordinary skill in the art to form the device of Meador et al with an extender to force the impact member from the retracted to the extended position to impact a work piece as taught by Schutz. The Examiner concluded that it would have been obvious to one having ordinary skill in the art to form the device of Meador et al with cock and release mechanism to provide a faster insertion of the fastener as taught by Schutz.

Claims 15 and 16 have been cancelled. Thus, the Applicant respectfully requests that this rejection be withdrawn.

J. Claim 18 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al. in view of Eby.

The Examiner stated that Meador et al. discloses all of the claimed subject matter except for having a handle pole with a sliding attachment. The Examiner further stated that Eby discloses a handle pole "116" attached to the proximal portion of an impact member and extends beyond a guide member, a sliding attachment portion (see tool "136" slidable on pole "116") whereby the device is usable to set a fastener or as a hammer. The Examiner concluded that it would have been obvious to one having ordinary skill in the art to provide the handle pole "30" of Meador et al. with a sliding attachment portion to allow for the impact member to be driven or for the attachment to a tool as taught by Eby.

Claim 18 has been cancelled. Thus, the Applicant respectfully requests that this rejection be withdrawn.

K. Claims 7, 11 and 19 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 7

Regarding Claim 7, the Applicant refers the Examiner to the comments above regarding Claim 3. As Borkwoski does not teach all of the claimed limitations in Claim 3, the Applicant believes that this Claim, which depends therefrom, is also allowable for at least the same reasons. Thus, the Applicant respectfully requests that this rejection be withdrawn.

Claim 11

Regarding Claim 11, the Applicant refers the Examiner to the comments above regarding Claim 3. As Borkwoski does not teach all of the claimed limitations in Claim 3, the Applicant believes that this Claim, which depends therefrom, is also allowable for at least the same reasons. Thus, the Applicant respectfully requests that this rejection be withdrawn.

Claim 19

Regarding Claim 19, the claim has been amended to include all of the limitations of the base claim and any intervening claims. Thus, the Applicant respectfully requests that this rejection be withdrawn.

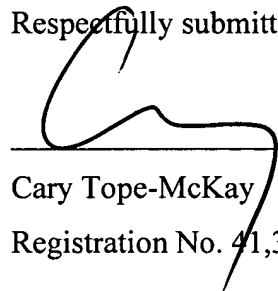
5 **Concluding Remarks:**

The Applicant respectfully submits that in light of the above comments and remarks, the Claims are now in allowable condition. The Applicants thus respectfully request timely allowance of the pending Claims.

10 In the event the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either Applicants or Applicants' representative would be beneficial the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

15 The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-2691. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed. The petition fee due
20 in connection therewith may be charged to deposit account no. 50-2691.

Respectfully submitted,

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